

## REMARKS

Claims 1-6, 8-10 remain in the application.

### A. 35 U.S.C. § 102(b)

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

### Kaufman- Claims 1-5, 8-9

Claims 1-5 and 8-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kaufman, et al. US 6,217,416 (hereinafter “Kaufman”) (Office Action, page 2). The Office contends that Kaufman discloses a slurry comprising a periodic acid molarity of about 0.004M to about 0.008M, that appears to overlap the claimed molarity of claim 1. However, Kaufman discloses a weight percent of periodic acid that is between 0.3 and 30 percent.

The applicants interpret the weight percentage as being defined as 0.3 to 30 grams of solute (periodic acid) per 100 grams (100 ml/0.1 L) of solution (water). Thus, given a molecular weight for periodic acid of about 192, 0.3 grams of periodic acid corresponds to roughly 0.01M concentration and 30 grams of periodic acid corresponds to roughly 1.5M concentration, which does not appear to overlap the claimed molarity. Therefore, since Kaufman does not teach or suggest all of the limitations of amended claim 1, from which claims 2-5 and 8-9 depend, it is respectfully submitted that claims 1-5 and 8-9 are not anticipated by Kaufman. Thus,

reconsideration and withdrawal of the Section 102(b) rejection of claims 1-5, 8-9 is respectfully requested.

B. 35 U.S.C. § 103(a)

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Kaufman in view of Lee-Claim 6

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaufman in view of Lee (Office Action, page 3). The Office contends it would have been obvious to name specific potassium salts (to which the Applicants do not concede). However, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The weight percentages disclosed by Kaufman suggest a molarity (moles per liter of solution) in the range of about 0.01M to about 1.5M, given a molecular weight of periodic acid of about 192. Because neither Kaufman nor Lee teach or even suggest the limitation of a slurry comprising periodic acid in the range of about 0.004M to about 0.008M, as does amended claim 1 from which claim 6 depends, claim 6 is not rendered obvious by Kaufman in view of Lee. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claim 6 is respectfully requested.

Kaufman in view of Sachan-Claim 10

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kaufman in view of Sachan (Office Action, page 4). The Office contends it would have been obvious to include CTAOH in the process of Kaufman (to which the Applicants do not concede).

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Because neither Kaufman nor Sachan teach or even suggest the limitations of amended claim 1, from which claim 10 depends, claim 10 is not rendered obvious by Kaufman in view of Sachan. Thus, reconsideration and withdrawal of the Section 103(a) rejection of claim 10 is respectfully requested.

In view of the foregoing remarks, the Applicants request allowance of the application. Please forward further communications to the address of record. If the Examiner needs to contact the below-signed Attorney to further the prosecution of the application, the contact number is (503) 264-0944.

Respectfully submitted,

Dated: April 4, 2005

/Kathy Ortiz/  
Kathy Ortiz  
Reg. No. 54,351  
Attorney for Applicants